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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/574,655	03/31/2006	Jeannie M. Arruda	MS0044P	7612
210 7590 07/31/2009 MERCK AND CO., INC P O BOX 2000 RAHWAY, NJ 07065-0907				
EXAMINER OH, TAYLOR V				
ART UNIT		PAPER NUMBER		
1625				
MAIL DATE		DELIVERY MODE		
07/31/2009		PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/574,655

Applicant(s)

ARRUDA ET AL.

Examiner

Taylor Victor Oh

Art Unit

1625

Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 24 June 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) 17 and 18 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-16, 19 and 20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-8508)
Paper No(s)/Mail Date 3/06
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Inventor's Patent Application
- 6) ☐ Other: _____

The Status of Claims:

Claims 1-16 and 19-20 are pending.

Claims 1-16 and 19-20 are rejected.

DETAILED ACTION

1. Claims 1-16 and 19-20 are under consideration in this Office Action.

Priority

2. It is noted that this application is a 371 of PCT/US04/34374 (10/18/04), which claims benefit of 60/513,284 (10/22/03).

Drawings

3. None.

Election/Restriction

Applicant's election with traverse of Group IA (claims 1-16 and 19-20) on 6/24/09 is acknowledged.

Claims 1-5, 8, 10-13, 15, 17-20 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to nonelected groups IA and II, there being no allowable generic or linking claim.

Applicants argue the followings:

1,. Since claims 17-18 are directed to methods of using the product, if the compounds of Group I are allowable, the method claims 17-18 should be rejoined to the extent that they are also allowable because of their use.

Regarding Applicants' argument, the examiner has noted Applicants' argument.

However, even if none-elected group of the claims were rejoined, this would not put all the claims for a condition for allowance automatically so long as there are still some issue present in the none-elected group of the claims. For example, the examiner may foresee that there might be an issue regarding the method claims in the pending application. Therefore, applicants' argument are not persuasive.

Claim Objections

Claims 1 and 20 are objected to because of the following informalities:

In claim 1, the following groups are recited in the claim:

(d) ~~-C(O)-heteroaryl-O-~~, (c) ~~-C(O)-heteroaryl~~,
(c) ~~-C(O)-heteroaryl-C(O)-~~,

They are belonged to the invention of Group IB; therefore, those limitation should be removed from the elected Group IA. Appropriate correction is required.

In claim 20, the following aspects of the claim are recited:

The chemical compounds are enclosed around the boxes and there are no commas among them and also there is no conjunction word "and" before the last chemical name. This type of the expression is improper.

Appropriate correction is required.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-16 and 19-20 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 1, the phrase "carbon a the end of X is attached to the carbon adjacent to the phenyl " is recited. This expression is vague and indefinite because the claim or the specification does not elaborate what is meant by the term "carbon a " Appropriate correction is required.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Taylor Victor Oh whose telephone number is 571-272-0689. The examiner can normally be reached on 8:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Janet Andres can be reached on 571-272-0867. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Taylor Victor Oh, MSD,LAC
Primary Examiner
Art Unit :1625

/Taylor Victor Oh/
Primary Examiner, Art Unit 1625
7/30/09